

Due Date: September 30, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
)	
Inventor: Ronald P. Cocchi et al.)	Examiner: Sheleheda, James R.
)	
Serial #: 09/783,241)	Group Art Unit: 2623
)	
Filed: February 14, 2001)	Appeal No.: _____
)	
Title: INTERNET SERVICE PROVIDER)	
<u>CALLBACK FOR SATELLITE SYSTEMS</u>)	

REPLY BRIEF OF APPELLANTS

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR §41.41, Appellants hereby submit the Appellants' Reply Brief on Appeal from the final rejection in the above-identified application, as set forth in the Office Action dated February 14, 2006, the Advisory Action dated May 23, 2006, and the Examiner's Answer dated July 31, 2007.

No fee is due at this time. However, should any fees be due, please charge any additional fees or credit any overpayments to Deposit Account No. 50-0383 of The DIRECTV Group, Inc.

L. REAL PARTY IN INTEREST

The real party in interest is The DIRECTV Group Inc., the assignee of the present

application.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

III. STATUS OF CLAIMS

Claims 1-39 have been cancelled.

Claims 40-66 are pending in the application.

Claims 40-43, 48-52, 57-61, and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano et al., U.S. Publication No. 2002/0055847 (Nakano) in view of Hunter et al., U.S. Publication No. 2002/0056118 A1 (Hunter).

Claims 46, 47, 55, 56, 64, and 65 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano and Hunter and further in view of Hayward et al., U.S. Publication No. 2003/0023703 (Hayward).

Claims 44, 45, 53, 54, 62, and 63 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano and Hunter and further in view of Yamamoto et al., U.S. Patent No. 6,166,778 (Yamamoto).

All of the above rejections are being appealed.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 40, 49, and 58 are generally directed to the transmission and receipt of subscriber renewal notices through a connection to the Internet (i.e. via an ISP) rather than receiving such notices via satellite broadcast transmission (see page 2, lines 8-11 and 25-30; page 12, line 24- page 13, line 11; and page 14, lines 6-10). Examining the words themselves, the plain meaning of the term “subscriber renewal notice” is a “renewal notice” for a “subscriber”. In other words, a notice for something that is being renewed for a subscriber is being sent via the Internet. It is also

clear that such renewal notices are separate from purchase information since both purchase information and renewal notices are also described in the specification as a separate type of notice (see page 12, line 24-page 13, line 11). Sending renewal notices over an ISP connection saves satellite bandwidth that may be made available for other broadcast information.

More specifically, claims 40, 49, and 58 first provide for receiving, in a set top box, broadcast signals through a tuner of the set top box (see page 7, lines 13-15). A presentation device connected to the set top box is enabled to display the broadcast signals (see page 8, lines 21-28). A communication module (that is different than the tuner) of the set top box is used to automatically connect to the Internet without the user requesting the connection. (see page 9, lines 19-28; page 11, lines 17-24; page 12, lines 10-16). A subscriber renewal notice is received over the connection to the Internet (see page 2, lines 8-11 and 25-30; page 12, line 24-page 13, line 11; and page 14, lines 6-10).

Again, an examination of the words in the term “subscriber renewal notice” indicates that it is a notice for something being renewed by a subscriber. In this regard, the American Heritage Dictionary, Fourth Edition, Copyright 2000, defines the term “renewal” as the act or the state of having been renewed. Thus, a renewal is not something new but is something that is being renewed.

In addition, Appellants note that the dependent claims provide further limitations. For example, claims 42, 51, and 60 specify that the subscriber renewal notice comprises service provider facility data that is used by the set top box on a monthly basis (see page 2, lines 25-30; page 14, lines 1-10).

Further, dependent claims 46, 47, 55, 56, 64, and 65 provide for the use of a phone number that is local to the set top box that is used to connect to the Internet (see page 11, lines 1-6 and 21-24; and page 12, lines 10-12).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 40-43, 48-52, 57-61, and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano et al., U.S. Publication No. 2002/0055847 (Nakano) in view of Hunter et al., U.S. Publication No. 2002/0056118 A1 (Hunter).

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2003/0023703 (Hayward).

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All of the above rejections are being appealed.

VII. ARGUMENT

A. The Advisory Action is Improper

In response to the final Office Action, Appellants submitted a request for reconsideration without amending the claims and setting forth various arguments. In response, the Advisory Action provides:

Furthermore, in response to applicant's argument that it is not typical for keys to be transmitted through the broadcast channel, applicant is provided with the following evidence as to this fact.
Morales (5,291,554) disclosing wherein decryption keys are transmitted through the broadcast satellite link (column 8, lines 24-59).
Bigham et al. (5,544,161) disclosing transmitting a decryption key through the broadcast channel (column 5, lines 26-44 and Fig. 1).
Wool (EP 898425 A2) disclosing wherein "package" keys for subscriber programming packages are downloaded to a subscriber through a broadcast channel (Fig. 1 and paragraph 14, paragraph 19 and 20).

Appellants note that accompanying the Advisory Action was a newly initialed PTO-892 Form with the above references.

Appellants further note that the above references and PTO-892 were first cited in the Advisory Action and were not cited previously by the Patent Office in any communications, official or otherwise.

In view of the above, Appellants submit that the Advisory Action and citation of new references after final was improper. In this regard, such a citation and reliance on new art should be in the context of an obviousness rejection and should not have been cited in an Advisory Action where the Appellants are limited in their ability to respond to the references.

Appellants further note that the response (filed by Appellants) prior to the final Office Action also did not amend the claims and Requested Reconsideration on similar grounds to that set forth in the response after final. Yet the Advisory Action was the first instance in which the above

references were cited. Such a citation of art fails to compact prosecution.

Appellants further note that the final Office Action was mailed on February 14, 2006 and Appellants filed the Request for Reconsideration on April 12, 2006 (i.e., within 2 months of the final Office Action). However, the Advisory Action was mailed on May 23, 2006. Accordingly, Appellants submit that there was insufficient time to consider and/or file any petitions relating to the citation of new art. Thus, Appellants are objecting to the citation of art in this Appeal.

Nonetheless, despite the impropriety of the citation and in an effort to compact prosecution, Appellants address the cited references in this Appeal Brief as set forth in further detail below.

B. Independent Claims 40, 49, and 58 Are Patentable Over The Prior Art

Appellant traverses the rejections of the independent claims for one or more of the following reasons:

(1) Nakano, Hunter, Hayward, and Yamamoto do not teach, disclose or suggest a renewal notice for a subscriber; and

(2) Nakano, Hunter, Hayward, and Yamamoto do not teach, disclose or suggest receiving a subscriber renewal notice over a connection to the Internet.

As set forth in the summary above, independent claims 40, 49, and 58 are generally directed to the transmission and receipt of subscriber renewal notices through a connection to the Internet (i.e. via an ISP) rather than receiving such notices via satellite broadcast transmission. The plain meaning of the term subscriber renewal notice is a renewal notice for a subscriber. In other words, a notice for something that is being renewed for a subscriber is being sent via the Internet. Sending renewal notices over an ISP connection saves satellite bandwidth that may be made available for other broadcast information.

The cited references do not teach nor suggest these various elements of Appellants' independent claims. In rejecting the claim elements relating to receiving subscriber renewal notices over the Internet, the Office Action relies on Hunter paragraph 79, 82, and 83. Paragraph 82 provides that a key for each 32-bit code movie is delivered to each customer household by phone/modem on a monthly basis. The paragraph further states that the keys are only provided when the customer household is current in payments and otherwise in good standing. As can be

seen from this text, the keys are keys for a particular movie. Such a key is neither similar to nor suggested by the claimed “subscriber renewal notice”. The plain language of the terms subscriber renewal notice indicate that it is a renewal notice for a subscriber and is not a key for a particular movie that is delivered on a monthly basis. Such a movie-based key is not a subscriber renewal notice.

Paragraph 83 further describes that a movie will playback at a specific user station only when three code keys (including movie code key C) are present. Thus, rather than providing a renewal notice for a particular subscriber over a connection to the Internet as claimed, Hunter describes the delivery of a key for a particular movie over a phone/modem on a monthly basis. Such a teaching is sufficiently distinct and does not render obvious the claimed invention.

In response to the above arguments, the final Office Action submits that such subscriber renewal notices are obvious in view of Hunter’s keys that are transmitted monthly to a customer household at the time of monthly billing queries if the customer is current in payments. The final Office Action further concludes that the monthly transmission of the keys to the customer (i.e., subscriber) is based upon the customer’s monthly payment, which therefore constitutes a service renewal.

Appellants respectfully disagree and traverse such an assertion. Namely, code keys B described in paragraph [0081] of Hunter are keys for all movies (which are transmitted by satellite and not by a phone or modem). Further, code keys C described in paragraph [0082] are keys for each available movie. Accordingly, code key B is not similar to the present invention because it is broadcast instead of being transmitted via the Internet as claimed. Further, code key B is for all available movies compared to a subscriber renewal notice sent to an individual user. In addition, code key C is not a renewal for a subscriber. Instead, the movies change and so do the keys. Accordingly, rather than renewing something, new keys for new movies are delivered as part of code key C. In this regard, code key C is not a renewal notice but merely a key for available movies. To assert that because the keys are only transmitted when a customer is current in monthly payments, that such keys are equivalent to subscriber renewal notices is a far stretch and extends well beyond the scope of Hunter. The customer’s monthly payment in Hunter is a precondition or a condition

precedent for sending the code key C – code key C is not a renewal for a subscriber but merely a key for an available movie. There is a distinct and significant difference between the two.

In addition, Appellants note that because it is a subscriber renewal notice, it can be understood that a package or something is being renewed for the subscriber – such an item cannot be per individual movies – movies change on a monthly or more frequent basis (i.e., pay-per views) – and can therefore not be renewed.

In response to the above, the Advisory Action provides:

In response, as indicated in the previous action, Hunter specifically discloses wherein the subscriber will be provided the proper key for each and every movie, on a monthly basis, if they are current in their payments. As keys for each movie are provided to the subscriber, based upon the subscriber's renewal of the service (bill payment), they clearly qualify as a "subscriber renewal notice". The keys are provided to a particular subscriber location to allow that particular subscriber to access any of the available movies (paragraphs 82 and 83). While the individual keys allow decryption of individual movies, ALL of the keys at the subscriber location are renewed on the basis of the subscriber paying their bill. As the keys for ALL the movies are provided to an individual subscriber on a monthly basis, they clearly meet the extremely broad claim limitation of a "subscriber renewal notice."

Appellants respectfully disagree with and traverse the above. Per the Patent Office's own admission above, the keys are for each movie. Thus, rather than constituting a renewal of a service and a notice of such a renewal, they are keys for each and every movie. Further, contrary to the above, the keys are not "renewed". Instead, they are new keys for each and every individual movie. Since there are new movies, there are new keys each month. Such new movies cannot constitute a "renewal" since by definition, a renewal is not new. Again, as stated above, providing keys for all movies to an individual subscriber on a monthly basis completely fails to describe or suggest, explicitly or implicitly, a renewal notice of a subscriber. Such keys are not "notices" that are renewed or new.

The Advisory Action then continues and provides:

Furthermore, it is noted that applicant's specification merely defines a "subscriber renewal notice" as "pay-TV service provider facility data" (see page 2, lines 25-29). As the code keys C, as defined by Hunter, are transmitted on a monthly basis to an individual subscriber, as a direct result of the subscriber PAYING their current fees, they clearly meet this limitation.

Appellants acknowledge that one definition used in the specification for "subscriber renewal notice" is pay-TV service provider facility data. Alternatively, on page 14, lines 6-10, the specification provides "Operator facility data such as subscriber renewal notices, that are typically

broadcast 118 monthly, may also be” Thus, a subscriber renewal notice is an example of type of operator facility data that is used in the invention. Thus, rather than being tied exclusively and wholly equivalent to “pay-TV service provider facility data” (as asserted by the Patent Office), the term “subscriber renewal notice” must be viewed in the context of the entire specification and the general and plain meaning of the term itself. In this regard, the terms must be examined for their clear meaning that is inherent on their face. Namely, a subscriber renewal notice is a notice for something being renewed by a subscriber. One can’t merely ignore such a plain meaning while ignoring that something is being “renewed” and attempting to read such language on prior art where keys are being sent for particular movies. Such an interpretation is wholly without merit.

The Action further continues and provides:

In response to applicant’s arguments on page 12, that the subscriber renewal notice is understood to renew a “package” for the subscriber,

1. It is noted that the definition applicant is attempting to provide to the subscriber renewal notice, i.e. as pertaining to some sort of “package”, as opposed to a particular movie, is not supported by the current specification, which does not define what the renewal notice pertains to.

2. As repeatedly pointed out to applicant, Hunter discloses wherein a subscriber will receive, on a monthly basis, code keys for EACH available movie. While not necessarily required by the current claim limitations, the current rejections are based upon the receipt of all of the code keys C. These keys together constitute the subscriber renewal notice, as they are renewed on a monthly basis to provide access to movies.

With respect to both items (1) and (2), Hunter’s movies are new each month and thus cannot be “renewed” as required by the claims. The keys are new keys for new movies that the user may view. Merely because a user is current in fees does not transition such keys into being considered a “renewal notice” as required in the claims. Using the analysis of the Examiner, anything sent to the user after the user is current in fees would be considered a subscriber renewal notice. For example, what if a user is delivered a list of new phone numbers but only if the user is current in their fees? The PTO would consider such a listing a subscriber renewal notice. However, such an interpretation is wholly without merit or support with respect to the present claims. Again, the claimed notice pertains to something that is specifically being “renewed” for a subscriber such as a package, service, or otherwise. Hunter’s movies are not being renewed by the subscriber. Further, Appellants submit that such a claim interpretation is completely within the scope and is supported by the present specification.

In response to the above, the Examiner's Answer provides that the code keys C for all of the available movies are provided on a monthly basis if the subscriber is current in payments. The Answer then concludes:

Thus, the subscriber's video subscription is being renewed every month. The available security keys for all of the available movies, which the user has paid to access, are then renewed every month if the user has paid their bill.

Appellants respectfully disagree with and traverse such an assertion. Again, as admitted in the Answer, the code keys C are provided for each movie. Further, each available movie changes every month. Thus, rather than renewing something, the code keys C are for new movies that were not previously available. Such keys cannot qualify as "subscriber RENEWAL notices".

The Answer then continue and provides that code keys C provide notice to the subscriber system on how to access and utilize the movies. Such a statement clearly admits that the notice is not a renewal as claimed but instead is a notice on how to access and utilize movies.

The Answer then contradicts itself and asserts:

Further, it is not any individual key for a particular movie which is being renewed, but all of the keys for the currently available movies for the month. The video service is paid for and renewed on a monthly basis, and the paying subscriber's system is then notified of the current security keys required for playback.

Such a statement acknowledges the lack of Hunter's teaching of the claim limitations. Namely, such a statement acknowledges that the video service is being renewed but the keys are security keys required for playback of particular movies. Thus, since the video service is being renewed, a different key for a particular movie cannot possibly be a subscriber renewal notice.

Further, the Answer asserts that Appellants description of how Hunter's system works with respect to code keys B and C are irrelevant (see Examiner's Answer page 14). Appellants respectfully disagree with and traverse such an assertion. Under MPEP 2141.02: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). As stated above, contrary to that asserted by the Examiner, code keys C are for individual movies and not for all of the movies. Code key B is for all of the movies and is explicitly broadcast by Hunter. The Examiner cannot assert that code keys C are for all movies while ignoring the explicit teaching of Hunter that teaches otherwise.

The Answer continues on page 15 and states:

Thus, it is the subscriber's video service which is being renewed every month. The new batch of code keys C provide notice to the subscriber system on the renewal to allow for playback of the available movies.

Appellants respectfully disagree with such an assertion. Since the subscriber's video service is being renewed each month, the notice must reflect such a renewal. The Examiner is attempting to twist the language and use of Hunter's keys into stating that the merely delivery of individual keys for particular movies constitute renewal notices as part of the video service that is being renewed each month. If the particular movie itself were being renewed (e.g., a bar desiring to repeatedly play a particular movie or sporting event), then the code key C may arguably act as a renewal notice. However, such a renewal is not occurring nor described in Hunter. Instead, individual code keys for individual movies are delivered to a customer household. Such a teaching is not what the current claims provide for.

The Answer then states on page 15 that all of the code keys C together constitute the subscriber renewal notice as they are renewed on a monthly basis. Again, the code keys are not renewed on a monthly basis. They are new keys each month for new movies each month. Such new keys are not renewals as claimed.

On page 17 of the Answer, the Examiner attempts to rephrase the claims in terms of several questions. Such a rephrasing of the claims is not a proper mechanism to evaluate claims. Instead, the claims as they appear must be evaluated. Further, the series of questions are ignoring the remaining elements set forth in Hunter. With respect to the Answer's "Subscriber" element, code keys C are for particular individual movies. The examiner is asserting that such code keys are for an individual subscriber. Appellants note that the cited paragraph does not teach that code keys C are subscriber specific. Instead, they are for movies regardless of who the subscriber is. The notices for the movies are delivered to a particular subscriber but are not coded for a particular subscriber. With respect to the Answer's "Renewal" element, the security keys for the movies are not being renewed as they keys are new each month and so are the movies - thus, there is nothing being renewed whatsoever. With respect to the Answer's "Notice" element, no notice is being provided

to Hunter's customer household. Instead, keys for individual available movies are provided to the customer's household - such keys are not notices of any form.

In view of the above, Appellants respectfully request reversal of the rejections of the independent claims.

C. Dependent Claims 41, 50, and 59 Are Patentable Over The Prior Art

Dependent claims 41, 50, and 59 provide for two particular items – (1) that the subscriber renewal notice is traditionally broadcast via satellite; and (2) broadcast information is transmitted via satellite using the bandwidth that is no longer consumed by the subscriber renewal notices. With respect to (1), there is no indication in Hunter that that Code key C is ever transmitted via satellite or that it is traditionally transmitted via satellite. Further, Hunter also fails to even remotely suggest the use of particular bandwidth for broadcast information.

In response to the above previously submitted arguments, the final Office Action states that the claim limitation is merely a benefit and while Hunter doesn't disclose such a benefit, Hunter inherently takes advantage of such a benefit. Appellants respectfully disagree. Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." The terms and stated manner in which the particular notices are traditional broadcast cannot merely be ignored with an assertion that the benefit of such limitations is inherent. Regardless of the benefit, the claim limitations exist.

In addition, Appellants note that the claim limitations also serve to distinguish subscriber renewal notices from code key C. In this regard, as set forth in Hunter, code key C is delivered by phone/modem for all available movies from a central controller system. Further, such keys are only when the customer household is current in payments. However, neither the Action nor Hunter has disclosed any transmission of all code keys C via a broadcast medium. In fact, Hunter discloses the opposite in that they are sent at the time of monthly billing queries and the only transmission described is that via phone/modem. Accordingly, Hunter's code key C cannot be the subscriber

renewal notice since the subscriber renewal notice is traditionally broadcast via satellite as set forth in dependent claim 41. The fact that Hunter completely fails to describe any manner other than transmission via phone/modem eliminates the possibility that code key C is equivalent to the claimed subscriber renewal notice.

In response to the above arguments, the Advisory Action provides:

On page 12, of applicant's response, applicant argues that Hunter does not specifically disclose that the subscriber renewal notice is typically transmitted via broadcast, and thus saves broadcast bandwidth by transmission via the Internet, and furthermore that this limitation was "ignored" by the statement that Hunter inherently takes advantage of this benefit.

In response, as indicated in the previous rejections, Hunter discloses the transmission of a subscriber renewal notice (consisting of decryption keys for programming) via the Internet. As indicated in the action, decryption keys are typically and known to be transmitted via the broadcast signal, and thus any transmission via the Internet, as opposed to the broadcast signal, saves broadcast bandwidth. Applicant's assertion that a limitation is somehow being "ignored" is incorrect. Transmitting the decryption keys through the Internet instead of the broadcast signal inherently saves broadcast bandwidth, as less data is then being transmitted through the broadcast channel.

Furthermore, in response to applicant's arguments that it is not typical for keys to be transmitted through the broadcast channel, applicant is provided with the following evidence as to this fact.

Morales (5,291,554) disclosing wherein decryption keys are transmitted through the broadcast satellite link (column 8, lines 24-59).

Bigham et al. (5,344,161) disclosing transmitting a decryption key through the broadcast channel (column 5, lines 26-44 and Fig. 1).

Wool (EP 898425 A2) disclosing wherein "package" keys for subscriber programming packages are downloaded to a subscriber through a broadcast channel (Fig. 1 and paragraph 14, paragraph 19 and 20).

Appellants respectfully disagree with and traverse such assertions. Firstly, contrary to that asserted in the Advisory Action, Appellants are not asserting that Hunter fails to specifically describe that subscriber renewal notices are typically broadcast. Instead, Appellants submit that Hunter's code key C is not equivalent to a subscriber renewal notice because the code key C is not broadcast. Appellants acknowledge that subscriber renewal notices are typically broadcast. The claims are directed towards freeing up the bandwidth used by such broadcast by sending the subscriber renewal notices via the connection to the Internet.

The Office Actions consistently provide that Hunter sends keys via the Internet. Appellants submit that since Hunter fails to disclose that his movie keys are broadcast, such keys cannot possibly be equivalent to the claimed subscriber renewal notices.

The Office Action relies on paragraphs [0079], [0082] and [0083] of Hunter for the keys transmissions. As stated above, the only key that is being asserted in the Office Action is that of

code key C because it is the only key that is delivered when the customer household is current in payments and otherwise is in good standing. The Office Action is relying on such payment currency so that the code key C for movies is considered a subscriber renewal notice (which Appellants traverse as set forth above). However, Hunter merely describes that such code key Cs are delivered by phone/modem on a monthly basis at the time of monthly billing queries from a central controller system (see paragraph [0082]). Again, such a key is never disclosed nor described to be disclosed via broadcast as claimed.

Appellants are not attempting to assert that decryption keys in general are broadcast. What differentiates the subscriber renewal notices from the keys of Hunter and those in Morales, Bigham, and Wool, is that the claims explicitly provide that the subscriber renewal notices are traditionally broadcast by satellite but are now being transmitted via the Internet. Neither the Office Action nor the cited references refer to such notices that renew something of a subscriber that are traditionally broadcast and that are now being sent via the Internet.

The Office Action is attempting to assert that Hunter's keys are traditionally broadcast via satellite. Such an assertion is wholly without merit. Instead, the keys that Hunter is referring to are delivered at the time of monthly billing queries and are keys for each available movie. Such a transmission is another factor that differentiates the presently claimed invention from that of Hunter.

Again, Appellants are not attempting to assert that keys are not broadcast. Appellants acknowledge that keys are broadcast. What Appellants are asserting is that a particular notice, a subscriber renewal notice, that is traditionally broadcast, is now being transmitted via an Internet connection thereby freeing up bandwidth. Such a teaching is neither taught nor suggested in the cited art.

In response to the above, the Examiner's Answer relies on Morales, Wool, and Bigham to teach that broadcasting decryption keys for video transmission is traditional and typical. Appellants note that the particular notices relied upon in the rejection - i.e., code keys C are never disclosed anywhere to being broadcast. In fact, other keys within Hunter are described as being broadcast. Such a teaching of broadcasting some but not broadcasting others explicitly teaches away from and illustrates that Hunter didn't even consider the possibility of broadcasting such notices.

Further, it would be impossible for Hunter to broadcast such code keys C. In this regard, code keys C are for each available movie. If they were broadcast, all users that receive the broadcast would have access to each available movie. Further, since the code keys C are only delivered to particular users that are current in payments, a broadcast would go out to all users and not particular users. Thus, contrary to that asserted by the Examiner, Hunter's code keys C cannot be traditionally broadcast and therefore fail to meet the explicit claim limitations.

Accordingly, Appellants respectfully request reversal of the rejections.

D. Dependent Claims 42, 51, and 60 Are Patentable Over The Prior Art

These claims provide that the subscriber renewal notice is service provider facility data.

In rejecting these claims, the Office Action relies on Hunter paragraphs 79 and 83. Paragraph 79 merely provides for the use of a time based code key to assure that playback of recorded content can only occur on currently authorized user stations. Paragraph 83 provides that playback will not occur unless three different code keys are present at the user station.

Again, the Patent Office only asserts that code key C is the subscriber renewal notice since that is the only key that is delivered when a subscriber is current in payments. Thus, to read on the invention, code key c must also be service provider facility data as claimed. However, Code key C is merely a 32-bit code for each available movie and is not service provider facility data. In this regard, the plain meaning of the terms "service provider facility data" does not even resemble a movie code.

Accordingly, Appellants respectfully request reversal of the rejection of these claims.

E. Dependent Claims 43, 52, and 61 Are Patentable Over The Prior Art

These claims provide that the subscriber renewal notice is received over a secure electronic connection.

In rejecting these claims, the Office Action relies on Nakano and Hunter. However, to teach the transmission of the notice over a secure connection, the Office Action relies on Hunter paragraph 83. Paragraph 83 provides:

[0083] The time-based coding of FIG. 8 assures that a movie will playback at a specific user station only when all three code keys A (transmitted with the movie), B (chosen and blanket transmitted monthly) and C (delivered monthly by phone modem) are present, with the user station software

simply verifying that C is the correct value when a predetermined mathematical function is applied to A and B.

As can be seen by this text, Hunter completely fails to describe delivering code key C over a secure electronic connection. Instead, key C is encoded and merely delivered via a phone/modem.

In view of the above, Appellants respectfully request reversal of the rejections.

F. Dependent Claims 44, 45, 53, 54, 62, and 63 Are Not Separately Argued

G. Dependent Claims 46, 47, 55, 56, 64, and 65 Are Patentable Over The Prior Art

Dependent claims 46, 47, 55, 56, 64, and 65 provide further limitations indicating that the connection to the Internet is conducted via a phone number that is local to the STB. Appellants note that the advantage provided by such a connection provides for eliminating the use of costly 800 number connections. In rejecting these claims, the final Office Action relies on Hayward. As set forth in Hayward and the final Office Action, Hayward is directed towards a computer system (see Abstract, Fig. 1, Fig. 2, and entire specification). Appellants submit that the use of a computer as set forth in Hayward is not even remotely similar to the use of a set top box. In this regard, applications or capabilities of a computer cannot be compared or used by a set top box in a system such as that set forth in the claims. In this regard, there is no motivation to use any system of a computer in an STB. The provided motivation relies exclusively on the benefit of dialing a local phone number to connect to the Internet. However, the completely different fields of art that exist between a computer and an STB would prevent such a combination and completely fail to provide a motivation to combine.

Under MPEP 2143, it is the Examiner's obligation to set forth a prima facie case of obviousness. As part of establishing the case, the Examiner must meet three criteria: he must show that some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20

USPQ2d 1438 (Fed. Cir. 1991). In this regard, there is no expectation of success if a computer of Hayward were combined with the systems of Nakano and/or Hunter. Further, there is no suggestion in either of the cited references, or in the art itself to combine the references as set forth in the Office Action.

In response to the above previously submitted arguments, the Advisory Action provides

In response to applicant's arguments on page 13, in regards to the combination of Hayward with Nakano and Hunter, applicant's arguments are not convincing. Nakano specifically discloses wherein the input device, while envisioned as a set top box, can constitute any device having access to the network (paragraph 12), even explicitly including a PC (paragraph 12). As Nakano clearly defines his set top box as being synonymous with a computer connecting to a network, Hayward's computer which connects to the Internet is clearly analogous art. Furthermore, as indicated in the rejection, the relied upon feature and motivation, of allowing dial-up connection to the Internet, are clearly unrelated to the particular network device, and would be relevant to any computing device.

Appellants respectfully traverse such assertions. There are significant differences between a PC and a set top box. While Nakano does describe that the input device can be a PC, the present invention is directed towards a set top box that performs the various functions and not a PC. A PC as set forth in Hayward has different functionality than that of a set top box.

Further, even by combining the references as indicated in the Office Action, the present invention would not result. The combination would merely provide for connecting a PC (as an input device of Nakano) wherein the PC performs the functionality set forth in Hayward. However, such a combination would not teach, disclose, or suggest, a set top box (and not a PC) that receives a local phone number, dials a local phone number (without the user requesting a connection), establishing a connection to the Internet through the connection, where the local number is for an ISP. Instead, a PC would perform a connection to the Internet. Such a teaching is significantly distinguishable from the present invention.

In response to the above, the Examiner essentially repeats the prior reply. Accordingly, Appellants reassert the above.

In view of the above, Appellants respectfully request reversal of the rejections.

H. Conclusion

In light of the above arguments, Appellants respectfully submit that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellants' claims recite

novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103. As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.

Respectfully submitted,

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G&C 109,41-US-01

CLAIMS APPENDIX

1.-39. (CANCELLED)

40. (PREVIOUSLY PRESENTED) A method for receiving a subscriber renewal notice comprising:

- (a) receiving, in a set top box, broadcast signals through a tuner of the set top box;
- (b) enabling a presentation device connected to the set top box to display the broadcast signals;
- (c) automatically connecting to the Internet using a communication module of the set top box without the user requesting the connection, wherein the communication module is different than the tuner; and
- (d) receiving a subscriber renewal notice over the connection to the Internet.

41. (PREVIOUSLY PRESENTED) The method of claim 40, wherein the subscriber renewal notice is traditionally broadcast via satellite, the method further comprising receiving broadcast information that utilizes satellite bandwidth no longer consumed by the subscriber renewal notice.

42. (PREVIOUSLY PRESENTED) The method of claim 40, wherein the subscriber renewal notice comprises service provider facility data.

43. (PREVIOUSLY PRESENTED) The method of claim 40, further comprising establishing a secure electronic connection with a server through the connection to the Internet, wherein the subscriber renewal notice is received through the secure electronic connection.

44. (PREVIOUSLY PRESENTED) The method of claim 40, further comprising:
receiving purchase information, for a good or service purchased by a user, wherein the purchase information was obtained through the user communicating with the set top box;
storing the purchase information for the good or service in the set top box; and
transmitting the purchase information from the set top box to a server through the connection to the Internet.

45. (PREVIOUSLY PRESENTED) The method of claim 44, wherein the purchase information is stored in a smart card.

46. (PREVIOUSLY PRESENTED) The method of claim 40, wherein the automatically connecting to the Internet comprises:

- receiving a local phone number in the set top box;
- automatically dialing the local phone number, without the user requesting a connection, using the communication module, wherein the communication module is a modem; and
- establishing the connection to the Internet through a computer that answers the dialed local phone number.

47. (PREVIOUSLY PRESENTED) The method of claim 46, wherein the local phone number is associated with an Internet service provider.

48. (PREVIOUSLY PRESENTED) The method of claim 40, wherein the automatically connecting comprises:

- determining if an Internet connection is currently established;
- if an Internet connection is currently established, automatically obtaining a new transmission control protocol/internet protocol (TCP/IP) connection through the communication module using the established Internet connection.

49. (PREVIOUSLY PRESENTED) A system for receiving a subscriber renewal notice:

- (a) a subscriber renewal notice;
- (b) a set top box configured to:
 - (i) receive broadcast signals through a tuner;
 - (ii) enable a presentation device to display the broadcast signals;
 - (iii) automatically connect to the Internet using a communication module of the set top box without the user requesting the connection, wherein the communication module is different than the tuner;
 - (iv) receive the subscriber renewal notice over the connection to the Internet.

50. (PREVIOUSLY PRESENTED) The system of claim 49, wherein the subscriber renewal notice is traditionally broadcast via satellite, wherein the set top box is further configured to receive broadcast information that utilizes satellite bandwidth no longer consumed by the subscriber renewal notice.

51. (PREVIOUSLY PRESENTED) The system of claim 49, wherein the subscriber renewal notice comprises service provider facility data.

52. (PREVIOUSLY PRESENTED) The system of claim 49, wherein the set top box is further configured to establish a secure electronic connection with a server through the connection to the Internet, wherein the subscriber renewal notice is received through the secure electronic connection.

53. (PREVIOUSLY PRESENTED) The system of claim 49, wherein the set top box is further configured to:

- receive purchase information, for a good or service purchased by a user, wherein the purchase information was obtained through the user communicating with the set top box;
- store the purchase information for the good or service in the set top box; and
- transmit the purchase information from the set top box to a server through the connection to the Internet.

54. (PREVIOUSLY PRESENTED) The system of claim 53, wherein the purchase information is stored in a smart card.

55. (PREVIOUSLY PRESENTED) The system of claim 49, wherein the set top box is configured to automatically connect to the Internet by:

- receiving a local phone number in the set top box;
- automatically dialing the local phone number, without the user requesting a connection, using the communication module, wherein the communication module is a modem; and
- establishing the connection to the Internet through a computer that answers the dialed local phone number.

56. (PREVIOUSLY PRESENTED) The system of claim 55, wherein the local phone number is associated with an Internet service provider.

57. (PREVIOUSLY PRESENTED) The system of claim 49, wherein the set top box is configured to automatically connect by:

- determining if an Internet connection is currently established;

- if an Internet connection is currently established, automatically obtaining a new transmission control protocol/internet protocol (TCP/IP) connection through the communication module using the established Internet connection.

58. (PREVIOUSLY PRESENTED) An article of manufacture for receiving a subscriber renewal notice comprising:

- means for a set top box connectable to a presentation device to receive broadcast signals through a tuner;

- means for the set top box to enable the presentation device to display the broadcast signals;

- means for the set top box to automatically connect to the Internet using a communication module of the set top box without a user requesting the connection, wherein the communication module is different than the tuner; and

- means for the set top box to receive a subscriber renewal notice over the connection to the Internet.

59. (PREVIOUSLY PRESENTED) The article of manufacture of claim 58, wherein the subscriber renewal notice is traditionally broadcast via satellite, wherein the article of manufacture further comprises means for the set top box to receive broadcast information that utilizes satellite bandwidth no longer consumed by the subscriber renewal notice.

60. (PREVIOUSLY PRESENTED) The article of manufacture of claim 58, wherein the subscriber renewal notice comprises service provider facility data.

61. (PREVIOUSLY PRESENTED) The article of manufacture of claim 58, further comprising means for the set top box to establish a secure electronic connection with a server through the connection to the Internet, wherein the subscriber renewal notice is received through the secure electronic connection.

62. (PREVIOUSLY PRESENTED) The article of manufacture of claim 58, further comprising:

means for the set top box to receive purchase information, for a good or service purchased by a user, wherein the purchase information was obtained through the user communicating with the set top box;

means for the set top box to store the purchase information for the good or service in the set top box; and

means for the set top box to transmit the purchase information from the set top box to a server through the connection to the Internet.

63. (PREVIOUSLY PRESENTED) The article of manufacture of claim 62, wherein the purchase information is stored in a smart card.

64. (PREVIOUSLY PRESENTED) The article of manufacture of claim 58, wherein the means for the set top box to automatically connect to the Internet comprises:

means for the set top box to receive a local phone number in the set top box;

means for the set top box to automatically dial the local phone number, without the user requesting a connection, using the communication module, wherein the communication module is a modem; and

means for the set top box to establish the connection to the Internet through a computer that answers the dialed local phone number.

65. (PREVIOUSLY PRESENTED) The article of manufacture of claim 64, wherein the local phone number is associated with an Internet service provider.

66. (PREVIOUSLY PRESENTED) The article of manufacture of claim 58, wherein the means for the set top box to automatically connect comprises:

means for the set top box to determine if an Internet connection is currently established; and
if an Internet connection is currently established, means for the set top box to automatically
obtain a new transmission control protocol/internet protocol (TCP/IP) connection through the
communication module using the established Internet connection.

EVIDENCE APPENDIX

Appellants note that U.S. Patent No. 5,544,161, U.S. Patent No. 5,291,554, and European Patent No. EP 898425 A2 were first cited by and relied upon by the Examiner in the Advisory Action dated May 23, 2006.

Such patents were entered into the record with the PTO-892 Form that was first cited and mailed to Appellant with the Advisory Action dated May 23, 2006.

RELATED PROCEEDINGS APPENDIX

None.